

### **REMARKS**

Applicant has reviewed the Office Action dated December 1, 2005 (hereinafter "Office Action"), and the references cited therewith.

Claims 1, 8, 9, 15, 17, 19, and 20 are amended, claims 21 and 22 are added, and no claims are canceled; as a result, claims 1-22 are now pending in this application. Applicant submits that the amendments and additions to the claims are fully supported by the specification as originally filed, and no new matter has been added.

Applicant hereby respectfully requests further examination and reconsideration of the application in view of the following remarks.

#### **§103 Rejection of the Claims**

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen et al. (U.S. Patent No. 4,998,975) in view of Tuominen (U.S. 2004/0167595A1). Applicant respectfully traverses such rejection on the basis that the Office Action failed to make out a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the cited reference (or references), or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438 (Fed. Cir. 1991)). According to *In re Lee*, "there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). "We do not 'pick and choose among the individual elements of assorted prior art references to recreate the claimed invention,' but rather, we look for 'some teaching or suggestion in the references to support their use in the particular claimed combination.'" *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 U.S.P.Q.2d 1241 (Fed. Cir. 1991).

Motivation to combine requires desirability, not merely a trade-off. Trade-offs often concern what is feasible, not what is necessarily desirable. Motivation to combine requires the latter. *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 53 U.S.P.Q.2d 15080 (Fed. Cir.), *cert. denied*, 530 U.S. 1238 (2000).

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed. Cir. 1986). A proposed combination that creates an inoperable reference teaches away from combination. When an office action proposes a combination that makes a prior art reference inoperable for its intended purpose, the resulting inoperable prior art reference may be considered to teach away from the proposed combination, i.e., not teach the combination, thereby supporting a showing of nonobviousness. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984)(finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

Second, the prior art reference (or references) must teach or suggest all of the claim limitations. M.P.E.P. § 2142.

Third, there must be a reasonable expectation of success. M.P.E.P. § 2142.

#### *Claims 1-20:*

Applicant submits the Office Action has failed to make out a *prima facie* case of obviousness for claims 1-20 because, among other things, there is legally insufficient motivation to combine the cited references (i.e., Cohen and Tuominen) and because all claim limitations cannot be found in Cohen nor Tuominen (alone or in combination).

#### *Claims 1-7:*

Using Cohen and Tuominen alone (e.g., without the use of the Applicant's disclosure), one of ordinary skill in the art would not have been motivated to combine the teachings of such references to produce "[a]n implantable lead comprising . . . one or more fillers disposed within the tubular lead body, the one or more fillers are disposed adjacent to the at least one conductor, but are not coupled with the conductor," as recited in Applicant's claim 1.

According to the Office Action, the motivation "to combine the teachings of Cohen with the elongate members/fillers of Tuominen" comes from the desire to "produc[e] a lead body with a smaller size to enable effective travel within [ ] vasculature [associated with the heart]," (Office

Action, p. 3); however, such assertion *prima facie* fails to establish a motivation to combine on at least three grounds. First, Applicant points out (that earlier in the communication) the Office Action states that the lead “configuration[ ] [in Cohen] ha[s] a reduced size to effectively minimize trauma to the tissue and avoid[ ] any potential problems of open chest surgery.” (Office Action, p. 2). It follows then, that no motivation exists for one of ordinary skill in the art to search for another lead body having a small, reduced size (in contrast to the position taken by the Office Action). The Office Action appears to be picking and choosing among individual elements of assorted references (i.e., Cohen and Tuominen) to recreate the claimed invention without some teaching or motivation in the references to support their use in the particular claimed combination, as prohibited by *Symbol Technologies, Inc.* 935 F.2d 1569. Motivation to combine requires desirability, not merely a trade-off. *Winner International Royalty Corp.*, 202 F.3d 1340.

Second, Applicant submits that a combination of the implantable lead recited in Cohen with the (Office Action asserted) fillers recited in Tuominen would result in a lead body greater in size than the lead body recited in Cohen. For instance, Cohen recites “a helically wound conductor having an electrically insulating sheath therearound . . . comprise a lead body.” (Col. 8, lns. 18-21). The insertion of “the [ ]/fillers of Tuominen” between the helically wound conductor and the electrically insulating sheath of Cohen (i.e., within the lead body as claimed by Applicant) would result in a lead body having a size greater than if the lead body consisted of only the helically wound conductor and the insulating sheath disposed therearound (as recited in Cohen). An increase in lead body size is a characteristic that Cohen teaches against. For instance, as stated by the Office Action, Cohen discloses a lead “configuration[ ] hav[ing] a reduced size to effectively minimize trauma to the tissue and avoid[ ] any potential problems of open chest surgery.” (Office Action, p. 2).

Third, Applicant submits that Cohen teaches against being combined with “the elongate members/[ ] of Tuominen.” Cohen recites “the conductor of the leads is preferably a helically wound wire” and “[i]f more than one conductor is required within the lead, two or more conductors may be helically wound coaxially, each having a different winding radius than the others, or the conductors may be placed side-by-side and helically wound on a common radius . . . [t]he conductors are helically wound as a spring in order to make the lead flexible without

sacrificing the structural integrity of the conductor.” (Col. 8, lns. 53-54 and 61-66; col. 9, lns. 2-5). Tuominen, on the other hand, recites “a plurality of elongated members 52, 53, and 54 . . . as illustrated in FIGS. 2 and 3, first elongated member 52 and second elongated member 53 are cable conductors [as opposed to helically wound conductors recited in Cohen].” ([0021]).

Notwithstanding the fact that there is legally insufficient motivation to combine Cohen and Tuominen, Applicant submits that all claim limitations are not found in Cohen nor Tuominen. For example, Applicant cannot find in Cohen nor Tuominen “one or more fillers disposed within the tubular lead body, the one or more fillers are disposed adjacent to the at least one conductor, but are not coupled with the conductor,” as recited in Applicant’s claim 1. The Office Action acknowledges Cohen fails to disclose “the claimed fillers disposed within the lead body.” (Office Action, p. 3), but relies on Tuominen for the missing claim limitations.

Tuominen, in contrast to the position taken by the Office Action, fails to make up for the (claimed) shortfalls of Cohen (e.g., one or more fillers disposed within the tubular lead body). Rather, Tuominen recites “electrical lead 200 includ[es] shaft 210 . . . a proximal end 230 of shaft 210 is inserted into a sleeve 215, which joins shaft 210 to bifurcated connector 220 , while a distal end 240 of shaft 210 is inserted into an insulative spacer 213 distal to electrode ring 214 . . . shaft 210 includes an outer surface 211, an inner surface 212 forming a plurality of lumen 32, 33, and 34 by means of a plurality of ribs 42, 43, and 44.” ([0019], [0020], [0021]). In brief, shaft 210 of Tuominen comprises the lead body of electrical lead 200, and (integrally) includes the (Office Action alleged) fillers of Tuominen (as opposed to the fillers being disposed within a tubular lead body as claimed by Applicant).

Because neither Cohen nor Tuominen teaches or suggests all of the claimed subject matter of Applicant’s claim 1, and no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 1. Claims 2-7 are dependent on claim 1 and are patentable for the reasons argued above, in addition to the elements in such claims.

*Claim 3:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 1-7 (of which claim 3 is included), Applicant cannot find in Cohen nor Tuominen (either

individually or in combination) all of the elements of Applicant's claim 3. Notwithstanding the fact there is legally insufficient motivation to combine the references, Applicant cannot find an "implantable lead . . . wherein the compression features include compression waves disposed on an inner perimeter of the one or more fillers," as recited in Applicant's claim 3. Rather, Tuominen (which the Office Action relies on) recites disposing compression lumens in "[a] shaft wall on either side of lumen 334." ([0038], *see also*, FIG. 5A). In brief, Tuominen does not recite compression feature(s) disposed on a filler perimeter as claimed by Applicant.

Because neither Cohen nor Tuominen teaches or suggests all of the claimed subject matter of Applicant's claim 3, Applicant respectfully requests withdrawal of the rejection of claim 3.

*Claim 4:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 1-7 (of which claim 4 is included), Applicant cannot find in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant's claim 4. Specifically, Applicant cannot find an "implantable lead . . . wherein two fillers are disposed within the lead body, each filler having a first end and a second end, and a first conductor is disposed between two first ends of the two fillers, and a second conductor is disposed between two second ends of the two fillers," as recited in Applicant's claim 4. Rather, Tuominen recites "FIG. 3 is a perspective view of a distal portion of a flexible sheet 210' from which shaft 210 is formed . . . shaft 210 includes an outer surface 211, an inner surface 212 forming a plurality of lumens 32, 33, and 34 by means of a plurality of ribs 42, 43, and 44 . . . rolling sheet 210' such that first longitudinal edge 30 meets with second longitudinal edge 31 [ ] form[s] shaft 210." ([0021], [0022], *see also*, FIGS. 3, 4A, 4D, and 5B). In brief, Tuominen recites that shaft 210 (the lead body of electrical lead 200) is formed via a single sheet member having integrated ribs (as opposed to two fillers disposed within the lead body as claimed by Applicant).

Moreover, according to the Office Action, the motivation to combine Cohen and Tuominen comes from the desire to "creat[e] a lead body having a reduced lead body size." (Office Action, p. 3). To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claims 1-7 (i.e., considering Cohen, no motivation

exists for one of ordinary skill in the art to search for another lead body having a small, reduced size; and a combination of the multiple conductor teachings of Cohen with the (Office Action asserted) fillers recited in Tuominen would result in a lead body greater in size than the lead body recited in Cohen).

Because neither Cohen nor Tuominen teaches or suggests all of the claimed subject matter of Applicant's claim 4, and no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 4.

*Claim 5:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 1-7 (of which claim 5 is included), Applicant cannot find (nor has the Office Action asserted) in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant's claim 5. Notwithstanding the fact there is legally insufficient motivation to combine the references, Applicant cannot find and the Office Action has not asserted an "implantable lead . . . further comprising a coiled conductor forming a lumen therein, the coiled conductor disposed within the lead body, and a coil conductor longitudinal axis is offset from a lead body longitudinal axis," as recited in Applicant's claim 5. Rather, the Office Action merely asserts "[w]ith reference to claim 5, Cohen teaches a coiled conductor forming a lumen through the center." (Office Action, p. 5).

Because the Office Action has failed to provide a specific reason(s) to support an obviousness rejection as required by *Ex parte Humphreys*, 24 U.S.P.Q.2d 1255 (B.P.A.I. 1992), and because Applicant cannot find in Cohen nor Tuominen all of the claimed subject matter of Applicant's claim 5, Applicant respectfully requests withdrawal of the rejection of claim 5.

*Claim 6:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 1-7 (of which claim 6 is included), Applicant cannot find (nor has the Office Action asserted) in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant's claim 6. Notwithstanding the fact there is legally insufficient motivation to combine

the references, Applicant cannot find and the Office Action has not asserted an “implantable lead . . . wherein the one or more fillers is generally C-shaped,” as recited in Applicant’s claim 6. Rather, the Office Action merely asserts “Tuominen teaches cables/elongate members disposed within the lead body that can be formed of silicone.” (Office Action, p. 3).

Because the Office Action has failed to provide a specific reason(s) to support an obviousness rejection as required by *Ex parte Humphreys*, 24 U.S.P.Q.2d 1255 (B.P.A.I. 1992), because Applicant cannot find in Cohen nor Tuominen all of the claimed subject matter of Applicant’s claim 6, and because no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 6.

*Claims 8-14:*

Using Cohen and Tuominen alone (e.g., without the use of the Applicant’s disclosure), one of ordinary skill in the art would not have been motivated to combine the teachings of such references to produce “[a]n implantable lead comprising . . . one or more fillers disposed within the inner surface of the lead body, each filler filling less than about 50% of the lead body cross-sectional area,” as recited in Applicant’s claim 8.

According to the Office Action, the motivation “to combine the teachings of Cohen with the elongate members/fillers of Tuominen” comes from the desire to “produc[e] a lead body with a smaller size to enable effective travel within [ ] vasculature [associated with the heart],” (Office Action, p. 3), however, such assertion *prima facie* fails to establish a motivation to combine on at least three grounds. To this end, Applicant hereby respectfully incorporates by reference the relevant arguments asserted above with respect to claims 1- 7 (i.e., considering Cohen, no motivation exists for one of ordinary skill in the art to search for another lead body having a small, reduced size; a combination of the implantable lead recited in Cohen with the (Office Action asserted) fillers recited in Tuominen would result in a lead body greater in size than the lead body recited in Cohen in opposition to the stated goals of Cohen; and Cohen teaches against being combined with the elongate members/[ ] of Tuominen).

Notwithstanding the fact that there is legally insufficient motivation to combine Cohen and Tuominen, Applicant submits that all claim limitations are not found in Cohen nor

Tuominen and the Office Action has failed to point out all such claim limitations. For example, Applicant cannot find (nor has the Office Action asserted) in Cohen nor Tuominen “one or more fillers disposed within the inner surface of the lead body, each filler filling less than about 50% of the lead body cross-sectional area,” as recited in Applicant’s claim 8.

Because the Office Action has failed to provide a specific reason(s) to support an obviousness rejection as required by *Ex parte Humphreys*, 24 U.S.P.Q.2d 1255 (B.P.A.I. 1992), because Applicant cannot find in Cohen nor Tuominen all of the claimed subject matter of Applicant’s claim 8, and because no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 8. Claims 9-14 are dependent on claim 8 and are patentable for the reasons argued above, in addition to the elements in such claims.

*Claim 9:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 8-14 (of which claim 9 is included), Applicant cannot find in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant’s claim 9. Specifically, Applicant cannot find an “implantable lead . . . wherein two fillers are disposed within the inner surface of the lead body,” as recited in Applicant’s claim 9. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 4.

Because neither Cohen nor Tuominen teaches or suggests all of the claimed subject matter of Applicant’s claim 9, and no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 9.

*Claim 10:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 8-14 (of which claim 10 is included), Applicant cannot find in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant’s claim 10. Specifically, Applicant cannot find an “implantable lead . . . wherein each filler is generally C-shaped,” as



recited in Applicant's claim 10. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 6.

Because the Office Action has failed to provide a specific reason(s) to support an obviousness rejection as required by *Ex parte Humphreys*, 24 U.S.P.Q.2d 1255 (B.P.A.I. 1992), because neither Cohen nor Tuominen teaches or suggests all of the claimed subject matter of Applicant's claim 10, and because no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 10.

*Claim 12:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 8-14 (of which claim 12 is included), Applicant cannot find (nor has the Office Action asserted) in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant's claim 12. Specifically, Applicant cannot find an "implantable lead . . . wherein the filler extends from a first end to a second end and having an inner perimeter therein, and an insulated coiled conductor is disposed within the C-shape and adjacent the inner perimeter," as recited in Applicant's claim 12. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 10.

Because the Office Action has failed to provide specific reasons to support an obviousness rejection as required by *Ex parte Humphreys*, 24 U.S.P.Q.2d 1255 (B.P.A.I. 1992), because Applicant cannot find in Cohen nor Tuominen all of the claimed subject matter of Applicant's claim 12, and because no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 12.

*Claim 13:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 8-14 (of which claim 13 is included), Applicant submits that Cohen teaches against being combined with "the elongate [cable conductor] members/[ ] of Tuominen." To this end, Applicant hereby incorporates by references the relevant arguments asserted above with respect

to claim 1 (i.e., Cohen recites the use of one or more helically wound wire conductors as opposed to cable conductors).

Because no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 13.

*Claim 14:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant's claims 8-14 (of which claim 14 is included), Applicant cannot find (nor has the Office Action asserted) in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant's claim 14. Specifically, Applicant cannot find an "implantable lead . . . wherein the at least one insulated cable conductor includes two cable conductors disposed directly adjacent to one another and between the first and second ends," as recited in Applicant's claim 14. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claims 12 and 13.

Because the Office Action has failed to provide specific reasons to support an obviousness rejection as required by *Ex parte Humphreys*, 24 U.S.P.Q.2d 1255 (B.P.A.I. 1992), because Applicant cannot find in Cohen nor Tuominen all of the claimed subject matter of Applicant's claim 14, and because no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 14.

*Claims 15-20:*

Using Cohen and Tuominen alone (e.g., without the use of the Applicant's disclosure), one of ordinary skill in the art would not have been motivated to combine the teachings of such references to produce "a method comprising . . . disposing two or more conductors within an insulative lead body having an outer surface and an inner surface, where the two or more conductors includes a coiled conductors and at least one cable conductor . . . ; and disposing one or more fillers within the lead body such that the fillers are confined, at least in part, by the lead

body inner surface without coupling the conductors with the one or more fillers,” as recited in Applicant’s claim 15.

According to the Office Action, the motivation “to combine the teachings of Cohen with the elongate members/fillers of Tuominen” comes from the desire to “produc[e] a lead body with a smaller size to enable effective travel within [ ] vasculature [associated with the heart],” (Office Action, p. 3), however, such assertion *prima facie* fails to establish a motivation to combine on at least three grounds. To this end, Applicant hereby respectfully incorporates by reference the relevant arguments asserted above with respect to claims 1- 7 (i.e., considering Cohen, no motivation exists for one of ordinary skill in the art to search for another lead body having a small, reduced size; a combination of the implantable lead recited in Cohen with the (Office Action asserted) fillers recited in Tuominen would result in a lead body greater in size than the lead body recited in Cohen in opposition to the stated goals of Cohen; and Cohen teaches against being combined with the elongate members/[ ] of Tuominen).

Notwithstanding the fact that there is legally insufficient motivation to combine Cohen and Tuominen, Applicant submits that all claim limitations are not found in Cohen nor Tuominen. For example, Applicant cannot find in Cohen nor Tuominen “disposing one or more fillers within the lead body such that the fillers are confined, at least in part, by the lead body inner surface without coupling the conductors with the one or more fillers,” as recited in Applicant’s claim 15.

Because Applicant cannot find in Cohen nor Tuominen all of the claimed subject matter of Applicant’s claim 15, and no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 15. Claims 16-20 are dependent on claim 15 and are patentable for the reasons argued above, in addition to the elements in such claims.

*Claim 16:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 15-20 (of which claim 16 is included), Applicant cannot find (nor has the Office Action asserted) in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant’s claim 16. Notwithstanding the fact there is legally insufficient motivation to

combine the references, Applicant cannot find and the Office Action has not asserted a “method . . . wherein disposing the coiled conductor within the lead body includes disposing the coiled conductor at a location offset from a longitudinal axis of the lead body,” as recited in Applicant’s claim 16.

Because the Office Action has failed to provide a specific reason(s) to support an obviousness rejection as required by *Ex parte Humphreys*, 24 U.S.P.Q.2d 1255 (B.P.A.I. 1992), because Applicant cannot find in Cohen nor Tuominen all of the claimed subject matter of Applicant’s claim 16, and because no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 16.

*Claim 17:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 15-20 (of which claim 17 is included), Applicant cannot find in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant’s claim 17. Specifically, Applicant cannot find a “method . . . wherein disposing the one or more fillers includes disposing two or more fillers on opposite sides of the coiled conductor,” as recited in Applicant’s claim 17. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 4.

Because neither Cohen nor Tuominen teaches or suggests all of the claimed subject matter of Applicant’s claim 17, and no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 17.

*Claim 19:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 15-20 (of which claim 19 is included), Applicant cannot find (nor has the Office Action asserted) in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant’s claim 19. Specifically, Applicant cannot find a “method . . . wherein disposing one or more fillers within the lead body includes disposing a C-shaped filler within the lead body, the

C-shape having an inner perimeter portion, and disposing the coiled conductor within the inner perimeter portion,” as recited in Applicant’s claim 15. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 12.

Because the Office Action has failed to provide a specific reason(s) to support an obviousness rejection as required by *Ex parte Humphreys*, 24 U.S.P.Q.2d 1255 (B.P.A.I. 1992), because Applicant cannot find in Cohen nor Tuominen all of the claimed subject matter of Applicant’s claim 19, and because no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 19.

*Claim 20:*

In addition to the foregoing grounds set forth supporting the patentability of Applicant’s claims 15-20 (of which claim 20 is included), Applicant cannot find in Cohen nor Tuominen (either individually or in combination) all of the elements of Applicant’s claim 20. Notwithstanding the fact there is legally insufficient motivation to combine the references, Applicant cannot find a “method . . . wherein disposing one or more fillers within the lead body includes disposing one or more fillers with compression features on an inner perimeter thereof within the lead body,” as recited in Applicant’s claim 20. To this end, Applicant hereby incorporates by reference the relevant arguments asserted above with respect to claim 3.

Because neither Cohen nor Tuominen teaches or suggests all of the claimed subject matter of Applicant’s claim 20, and no legally sufficient motivation to combine the subject matter of Cohen with the subject matter of Tuominen has been provided, Applicant respectfully requests withdrawal of the rejection of claim 20.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3276 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

GREGORY L. SUNDBERG

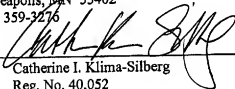
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1 day of March, 2006.

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